

REMARKS

Claims 1, 9, 12, 16 through 25, 30, 32, 36, 40, 42 through 44, and 46 through 58 are pending in this Application. Claim 45 has been canceled without prejudice or disclaimer. Claims 1, 19, 23, and 43 have been amended, and new claims 46 through 58 have been added. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the Abstract, FIG. 2, and ¶¶ [0035], [0049] through [0052], [0061], and [0065] of the corresponding US Pub. No. 2002/0187772. Applicants submit that the present Amendment does not generate any new matter issue.

Personal Interview of March 16, 2010.

Applicants express appreciation for the Examiner's courtesy in granting and conducting a personal interview on March 16, 2010. During the interview, the Examiner indicated that the present claim amendments would require a new search. It is with that understanding that the present Amendment is submitted.

Claim 45 was rejected under the first paragraph of 35 U.S.C. §112 for lack of adequate descriptive support.

In the statement of the rejection, the Examiner asserted that the claim recitation "a computer-readable storage medium carrying one or more sequences of one or more instructions which, when executed by one or more processors" is not adequately described in the specification. This rejection is traversed.

Initially, literal support is not required by the statute. *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d at 923; *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566-67

(Fed.Cir.1997). An applicant need not utilize any particular form of disclosure. *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed.Cir.2008) (quoting *In re Alton*, 76 F.3d 1168, 1172 (Fed.Cir.1996)). Further, a patent applicant has the right to narrow an originally disclosed invention. *In re Johnson*, 558 F.2d 1008 (C.C.P.A.)

In applying the above legal tenets to the exigencies of this case, Applicants submit that the imposed rejection is not factually accurate. Applicants respectfully submit that the originally-filed disclosure fully supports the above claim recitation. Specifically, a processor means 6 and a data storage means 7 of a mobile station 1 are shown in FIG. 1 and discussed in ¶ [0028] of the corresponding US publication. The recitation of “a computer-readable storage medium carrying one or more sequences of one or more instructions which, when executed by one or more processors” in claim 45 is fully supported by at least the processor means 6 and the data storage means 7.

In addition, Applicants respectfully submit that one of ordinary skill in the art with the originally-filed disclosure in hand would have understood that “executable instructions” and “computer program code” are inherently embodied on a medium, such as the processor means 6 and the data storage means 7. Certainly, one having ordinary skill in the art would have understood that Applicants had possession of the claimed invention at the time the application was filed.

To accelerate the prosecution, claim 45 has been cancelled without prejudice or disclaimer, the rejection becomes moot. Applicants therefore solicit withdrawal of the rejection of claim 45 under the second paragraph of 35 U.S.C. §112.

Claims 1, 9, 12, 16, and 18 through 22 were rejected under 35 U.S.C. §112, second paragraph.

In the statement of the rejection, the Examiner asserted that it is unclear whether the recited “input by a user” is verified in claim 1. Since the claim recitation “input by a user” has been removed, the rejection has been rendered moot. Applicants therefore solicit withdrawal of the rejection of claims 1, 9, 12, 16, and 18 through 22 under the second paragraph of 35 U.S.C. §112.

Claims 1, 9, 12, 16, 18 through 25, 30, 32, 36, 37, 40, and 42 through 45 were rejected as obvious under 35 U.S.C. §103(a) based on *Breck et al.* (US 2004/0210449, “*Breck*”) in view of *Capitant et al.* (US 6976011, “*Capitant*”).

In stating the rejection, the Examiner asserted that one having ordinary skill in the art would have been led to modify *Breck*’s transaction system by verifying *Capitant*’s subscriber identity module (SIM) or international mobile subscriber identity (IMSI), to securely execute data by using SIM or IMSI. Applicants respectfully traverse this rejection.

The claimed inventions advantageously enable a user to authorize the insertion of data in the data fields in a form based on an identification code associated with the user equipment, e.g., IMSI of 15 digits long, or an international mobile equipment identity (IMEI) of at least 14 decimal digits. As known to one of ordinary skill in the art, IMSI is a mobile equipment identity code assigned by a manufacturer of the user equipment, and IMEI is a mobile subscriber identity code assigned by a mobile service operator to a subscriber during initiation of the user equipment. These codes are not only globally unique, but also long thus providing stronger protection than regular PINs or passwords.

For example, the user equipment verifies internally that the automatic information insertion procedure is allowed. In particular, the user equipment verifies the automatic information insertion independently without interacting with an external device, such as

inputting the code by an user as described in ¶¶ [0049] through [0052]). The user equipment may ask for the ID code every time the controller of the wallet function recognizes that a form is to be filled in. As another example, the automatic form filling is in an authorized state if the ID code was verified when the user equipment was switched on (¶¶ [0049] through [0051]).

Specifically, independent claims 1 and 23 recite, *inter alia*: “verifying internally at the user equipment, at least in part on the basis of an identification code associated with the user equipment, that automatic insertion of information into at least one of the data fields of the information entity is allowed, the identification code being **a mobile equipment identity code assigned by a manufacturer of the user equipment, wherein the user equipment is a mobile phone.**” As admitted by the Examiner during the interview, *Breck* and *Capitant* do not teach that the identification code is a mobile equipment identity code assigned by a manufacturer of the user equipment (e.g., IMEI).

It is therefore apparent that even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite realistic motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir.1988). Applicants, therefore, submit that the imposed rejection of claims 1, 9, 12, 16, 18 through 25, 30, 32, 36, 37, 40, and 42 through 45 under 35 U.S.C. §103 for obviousness based on *Breck* in view of *Capitant* is not factually or legally viable and, hence, solicit withdrawal thereof.

New claims 46 through 58.

New independent claim 46 recites similar features as independent claim 1 and, hence, is free of the applied prior art for reasons advocated *supra* with respect to independent claim 1.

In particular, the applied prior art is silent with respect to the limitations in claim 46, i.e., the identification code being a mobile subscriber identity code assigned by a mobile service operator to a subscriber during initiation of the user equipment (e.g., IMEI), wherein the user equipment is a mobile phone. *Breck's* card reader is not a mobile phone, and *Breck's* smart card/card reader operates independently from any mobile phone. In *Capitant*, the payment server 4 authenticates a buyer, and *Capitant's* mobile phone has to work with the server, rather than "verifying internally at the user equipment," let alone "verifying internally at the user equipment that the automatic insertion of information into at least one of the data fields of the information entity is allowed". *Capitant* uses an IMSI of the buyer only to indentify an e-wallet of the buyer, which has nothing to do with "verifying that the automatic insertion of information into at least one of the data fields of the information entity is allowed." Neither reference teaches or suggests using IMSI to **authorize automatic insertion of information**.

In addition, one of ordinary skill in the art would not have been motivated to combine *Breck* and *Capitant* as suggested by the Examiner, since *Breck* requires a smart card reader while *Capitant* is a stand-alone mobile phone. *Breck's* smart card and card reader operate independently from the mobile phone of *Capitant*. It is not apparent, and the Examiner did not favor the record with sound reasoning to explain, why one skilled in the art would have been motivated to combine paying with a smart card with paying with a mobile phone.

New claims 47 through 55 depend from independent claim 1, and new claims 56 through 58 depend from independent claim 46. Applicants submit that claims 47 through 58 are free of the applied prior art for reasons advocated *supra* with respect to independent claims 1 and 46.

Accordingly, claims 46 through 58 are free of the applied prior art.

Based upon the foregoing, it is apparent that the imposed rejections have been overcome, and that all pending claims are in condition for allowance. Favorable consideration is therefore solicited. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-822-7186 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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Date

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